



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/786,355

02/25/2004

Eileen C. Shapiro

1525B/116

4565

2101 7590 09/16/2010  
Sunstein Kann Murphy & Timbers LLP  
125 SUMMER STREET  
BOSTON, MA 02110-1618

EXAMINER

DEBNATH, SUMAN

ART UNIT

PAPER NUMBER

2435

NOTIFICATION DATE

DELIVERY MODE

09/16/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATENTS@SUNSTEINLAW.COM

<p align="center"><b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b></p>	<p><b>Application No.</b> 10/786,355</p>	<p><b>Applicant(s)</b> SHAPIRO ET AL.</p>	
	<p><b>Examiner</b> SUMAN DEBNATH</p>	<p><b>Art Unit</b> 2435</p>	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 16 August 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: None.  
Claim(s) objected to: None.  
Claim(s) rejected: 1-16.  
Claim(s) withdrawn from consideration: None.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

/Kimyen Vu/  
Supervisory Patent Examiner, Art Unit 2435

Continuation of 11. does NOT place the application in condition for allowance because: Applicant argues that: "[t]he combination would not be obvious to a person having ordinary skill in the art, because it would render Walker unsuitable for its intended purpose."

In response to Applicant's argument that the combination would not be obvious to a person having ordinary skill in the art, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, motivation for the rejections is found both in the knowledge generally available to one of ordinary skill in the art and in the cited references.

Applicant argues that: "The Office cites col. 8, lines 17-29 of Ballantyne, which states in part that a "unique identification number (ID) is assigned to each user and their personal profile data is stored electronically online." However, the claims require communicating the candidate identifier to the candidate."

Examiner asserts that Ballantyne teaches the concept of communicating the identification number by assigning the unique identification number to each user and their personal profile data. Furthermore, it should be noted that Applicant didn't explicitly define in the claim language how the communication of identification was made. Ballantyne teaches that identification was received from users and validated against central user list (e.g. see, col. 8, lines 28-31). Thus, identification was communicated to the user prior hand.

Applicant argues that: "The patient information in Ballantyne is never described as being accessible by an identifier passed on to the patient, as required by the claims. Because Ballantyne fails to fill the gap left by Walker, the applicants respectfully request that the rejection be withdrawn."

Examiner asserts that Ballantyne teaches the concept of passing the identifier to the candidate by assigning unique identification number to each user and associating personal data with the identification number and storing the data online (col. 8, lines 17-29). Whenever user wants to retrieve the data, user submits the unique identification number which is validated against central user list before user can access to their personal profile data that is stored electronically online (e.g. see, col. 8, lines 28-31).

Applicant argues that: "[i]t cannot possibly be the case in limitation (C ) that the outside user has "received the candidate identifier directly or indirectly from the candidate."

Examiner asserts that Bisbee discloses transferring of electronic document to an outside agent, wherein a certificate is appended with the electronic document. Bisbee discloses that "the certificate may include information representing the Transfer Agent's identity, public cryptographic key, and predetermined attributes." Thus, Transfer Agent's identifier was transferred to the outside user (e.g. see, col. 3, lines 3-11, see also, col. 3, lines 30-37, col. 5, lines 28-38).

Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the Applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the Examiner. .